

REMARKS

Claims 1-10, 19-22 and 40-47 are pending in the instant application. Claim 5 stands withdrawn from consideration pursuant to the Examiner's Restriction Requirement, made final in the Office Action dated 08 January 2004. In the most recent Office Action, claims 1-4 and 6-9 and 40-47 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Pat. No. 5,852,485 to Shimada, et al. (hereinafter, "Shimada") in view of U.S. Pat. No. 6,198,520 to Kondo, et al. (hereinafter, "Kondo"). Claims 10 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Shimada in view of Kondo, and further in view of U.S. Pat. No. 6,469,764 to Kim, et al. (hereinafter, "Kim"). Claims 19-21 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Shimada in view of Kondo and Kim, and further in view of U.S. Pat. No. 6,023,317 to Xu, et al. (hereinafter, "Xu") and U.S. Pat. No. 5,677,747 to Ishikawa, et al. (hereinafter, "Ishikawa"). Claim 22 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Shimada in view of Kondo and Kim, and further in view of U.S. Pat. No. 6,160,604 to Murai, et al. (hereinafter, "Murai"). Applicant respectfully traverses all rejections for at least the reasons set for the below.

Independent claim1 recites a liquid crystal display device comprising, *inter alia*, a gate insulation film disposed on a first substrate and between a gate and a source or a drain of at least one thin film transistor, a protection film disposed on said gate insulation film or said plural thin film transistors; and an interlayer separation film is disposed above a color filter layer. The Office Action acknowledges, as it must, that neither Shimada, nor Kondo, teaches both a gate insulation film and a protection film. Rather, the Office Action avers at p. 5 that by combination of the two references, the alleged combination would provide both a 'protection' layer (4)

disclosed in Kondo, over a gate insulation film (23) as disclosed in Shimida, together with an interlayer separation film (insulating layer 4) from Kondo. Applicant respectfully disagrees.

In the first case, the structure the Office Action refers to as the protection layer (4) of Kondo is in fact an insulating layer, as the Office Action itself later acknowledges (See, Kondo, Col. 6, lines 1-16). The insulating layer of Kondo separates the common electrodes (2) from pixel electrodes (3) and scanning electrodes (21). On the other hand, Shimida also teaches a gate insulating film (23), separating gate electrode (22') from source line (28a) and drain electrode (28b) (See, Shimida, Col. 27, lines 4-20). Therefore, even presuming, *arguendo*, that one skilled in the art would be motivated to combine Shimida and Kondo in some fashion, there is no motivation to duplicate the single insulation film present in both structures and performing similar functions in each. Rather, for whatever other differences would be engendered by the alleged combination, the resulting liquid crystal display would have only one insulating layer, for each reference teaches that only one insulating layer is necessary. The references must be considered for all they teach, even that which would lead away from the claimed invention. See, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Furthermore, even the alleged combination as proposed by the Office Action does not reach the claimed invention. In the first instance, the cited structure of Kondo is an insulation film, not a protection film. Moreover, the Office Action avers that the insulating layer (4) taught by Kondo, in combination with Shimida, would read on both the recited protection film and the recited interlayer separation film. It is, however, improper to read a single structure in the reference on two discrete structures recited in the claim. See, *Lantech Inc. v. Keip Machine Co.*, 32 F.3d 542, 31 USPQ2d 1666 (Fed. Cir. 1994). Further, what the Office Action proffers as the interlayer separation film (insulating layer 4 of Kondo), is not positioned above the color filter

layer (5), as further recited in the claim. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For at least these reasons, applicant respectfully submits that the rejection of claim 1 has been obviated, and kindly solicits favorable reconsideration and withdrawal of the rejection.

Claims 2-4, 6-10, 19-22 and 40-47 each depend, either directly or indirectly, from claim 1. Each ground of rejection set forth in the Office Action is premised upon the application of Shimida and Kondo to the structure recited in claim 1, which has been obviated above. Neither Kim, Xu, nor Ishikawa, taken singly or in any combination with each other or Shimida and Kondo, offer any teaching or suggestion to ameliorate the deficiencies of the Shimida and Kondo relative to claim 1. While these dependent claims are each separately allowable, they are submitted as allowable for at least the same reasons as the underlying independent base claim.

In the interest of brevity, Applicant has addressed only so much of the rejection(s) as is considered necessary to demonstrate the patentability of the claim(s). Applicant's failure to address any part of the rejection should not be construed as acquiescence in the propriety of such portions not addressed. Applicant maintains that the claims are patentable for reasons other than these specifically discussed, *supra*.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicits an early indication of allowability of all claims. In light of the allowability of generic claim 1, rejoinder of withdrawn claim 5 is kindly requested. If the Examiner has any reservation in allowing all claims, and believes that a telephone interview

would advance prosecution, they are kindly requested to telephone the undersigned at an earliest convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David J. Torrente", with a long horizontal flourish extending to the right.

David J. Torrente
Registration No. 49,099

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza - Ste. 300
Garden City, New York 11530
(516) 742-4343

DJT:nf